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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,758	06/05/2006	Igor Chorvath	DC5193 PCT1	8725
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EXAMINER				
LOEWE, ROBERT S				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
04/04/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

Office Action Summary

Application No.

10/581,758

Applicant(s)

CHORVATH ET AL.

Examiner

ROBERT LOEWE

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 is/are rejected.
7) ☒ Claim(s) 7, 10 and 11 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 6/5/06
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 7 is objected to because of the following informalities: "at least one organofunctional groups selected" is incorrect and should be changed to --at least one organofunctional group selected--. Appropriate correction is required.

Claims 10 and 11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. See MPEP § 608.01(n). Accordingly, claims 10 and 11 will not be treated on their merits.

Claim Interpretation

Instant claim 1 recites a mandatory curing agent [component (C)] and an optional catalyst [component (F)]. It is the position of the Examiner that a free radical initiator/organic peroxide catalyst present in a composition which discloses the other mandatory ingredients of instant claim 1 would effectively satisfy the limitations of both instant claims 5 and 8. There is nothing to suggest in instant claim 1 that two distinct/different catalysts be added. A cure agent and a catalyst can be one in the same; therefore a free radical initiator/organic peroxide crosslinking system inherently serves as both a curing agent and a catalyst [components (C) and (F)].

International Search Report

US Pat. 6,015,858, cited on the international search report as an "X" reference, does not teach the same order of mixing as instant claim 1 but is relied upon as a "Y" reference below.

EP-636663, cited on the international search report as an "X" reference, does not teach the same order of mixing of instant claim 1 and does not teach dynamic vulcanization.

EP-697437 (equivalent to US Pat. 5,480,930), cited on the international search report as an "X" reference, does not teach the same order of mixing of instant claim 1 and does not teach dynamic vulcanization.

EP-380104 (equivalent to US Pat. 4,946,883), cited on the international search report as an "X" reference, does not teach the same order of mixing of instant claim 1 and does not teach dynamic vulcanization.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gornowicz (US Pat. 6,015,858).

Claims 1-8: Gornowicz teaches a method of preparing a fluoroplastic silicone composition by (I) reacting a fluorocarbon resin/fluoroplastic, such as a poly(vinylidene difluoride) homopolymer (3:52-64), a grafting agent/compatibilizer, such as triallyl isocyanurate (4:20-25), and a radical initiator, such as an organic peroxide (5:7-40) to form a modified fluorocarbon resin/fluoroplastic followed by (II) mixing the modified fluorocarbon resin/fluoroplastic with a silicone base composition comprises of a diorganopolysiloxane having at least two alkenyl radicals (5:41-6:61) and a reinforcing filler (6:62-7:27), an organohydrogenpolysiloxane crosslinking agent (7:28-8:34), and a platinum catalyst curing agent (8:35-58), followed by dynamic vulcanization (abstract). Gornowicz further teaches that amount of fluorocarbon resin/fluoroplastic is from 40 to 95% based on the total weight% of the other components. Given that the silicone base resin is a major component in the composition, it inherently follows that Gornowicz satisfies the ratio of fluorocarbon resin/fluoroplastic to silicone base of instant claim 1.

Gornowicz does not explicitly teach that ingredients (A) through (C) of instant claim 1 are first mixed prior to addition with ingredients (D) through (F). In the absence of a showing by the Applicants, the courts have stated that selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results (*In re Burhans*, 154 F.2d 690,

69 USPQ 330 (CCPA 1946)) and *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is prima facie obvious.)

Gornowicz teaches the presence of both a platinum-based hydrosilation catalyst and a free radical peroxide initiator. It follows that the free radical peroxide initiator functions as both a cure agent and a catalyst [i.e., as both components (C) and (F)].

Claim 9: Gornowicz further teaches that the mixing and curing steps are performed in an extruder (claim 10).

Claims 1-4, 6-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koford (US Pat. 4,488,771), in view of Stella (US Pat. 4,882,386).

Claims 1-4, 6-7 and 9: Koford teaches a method of preparing a fluoroplastic composition by mixing a vinyl end-blocked polydimethylsiloxane, a reinforcing fumed silica, an organohydrogenpolysiloxane crosslinking agent, a platinum-based cure agent and perfluorinated hydrocarbon/fluoroplastic, such as a tetrafluoroethylene telomer (Example). Koford further teaches that the ratio of fluoroplastic (D) to silicone compound (A) falls within the range of instant claim 1 (Example). Koford further teaches that the mixing and curing can be performed using as press curing (5:20-22). However, Koford is not limited to this type of molding and curing process as Koford teaches that standard molding and curing techniques can be employed (4:17-19).

Koford does not explicitly teach mixing and curing by extrusion molding. However, Stella teaches a method of mixing and curing a rubber composition using an extruder (8:5-10).

Koford and Stella are combinable because they are from the same field of endeavor, namely, the processing of curable rubber compositions. At the time of the invention, a person having ordinary skill in the art would have found it obvious to employ perform both mixing and curing steps using an extruder in the process of Koford and would have been motivated to do so because Stella teaches that such a process allows for a continuous manufacture of cured silicone rubber (8:19-31).

Koford does not explicitly teach that ingredients (A) through (C) of instant claim 1 are first mixed prior to addition with ingredients (D) through (F). In the absence of a showing by the Applicants, the courts have stated that selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results (*In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946)) and *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is *prima facie* obvious.)

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 7-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 7-9 and 11-13 of copending Application No. 10/581,474. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending application claims the same ingredients as the instant application. Specifically, the only discernable difference between the two applications is that the instant application employs as component (D) a fluoroplastic, which copending application '474 employs as component (D) a fluorocarbon elastomer, which is one type (species) of fluoroplastic.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-5, 7, and 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 8, 10-14 and 20-22 of U.S. Patent No. 7,173,092. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and US Pat. 7,173,092 differ only in the order of mixing of components (A) through (F). However, the courts have stated that selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results (*In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946)) and *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is *prima facie*

obvious.) The only other discernable difference between the two sets of independent claims is that the instant application employs as component (D) a fluoroplastic, while copending application '474 employs as component (D) a fluorocarbon elastomer, which is one type (species) of fluoroplastic.

Relevant Art Cited

The prior art made of record and not relied upon but is considered pertinent to applicants disclosure can be found on the attached PTO-892 form.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

Art Unit: 1796

like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L./

Examiner, Art Unit 1796

3-Mar-08

/Randy Gulakowski/

Supervisory Patent Examiner, Art Unit 1796